

## REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed February 21, 2008. At the time of the Final Office Action, Claims 1-20 were pending in this Application. Claims 1-20 were rejected. Claims 1 and 20 have been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

### **Rejections under 35 U.S.C. § 102**

Claims 1-20 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,697,882 or U.S. Patent No. 5,871,469 or U.S. Patent No. 5,683,366 all issued to Eggers et al. ("Eggers"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

Claims 1, 3-11 and 17-20 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,936,281 issued to Stasz ("Stasz"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the art cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

With regard to claims 1 and 20, the Examiner contends that Eggers discloses an electrosurgical probe with at least one active electrode terminal comprising a body having a suction opening formed therein, the suction opening in communication with the electrode lumen. However, Eggers does not describe a suction opening that is longitudinally formed in the electrode terminal body and is laterally oriented on the wall of the body, as is now recited by amended claims 1 and 20. In contrast, Eggers discloses hollow electrode structures with openings present only at both ends of the cylindrical structure. Therefore, Eggers does not

disclose an electrode structure with a suction opening longitudinally formed in the electrode body that is laterally oriented on the wall of the body, and cannot anticipate claims 1 and 20 as amended. Applicants respectfully submit that amended claims 1 and 20 are in condition for allowance, and request withdrawal of the rejection.

Claims 2-19 depend either directly or indirectly from amended claim 1. Applicants repeat and hereby incorporate the remarks made above regarding amended claim 1. For these reasons, Applicants respectfully submit that claims 2-19 are also allowable over Eggers.

Similarly, Applicants repeat and hereby incorporate the remarks made above with regard to the Examiner's rejection of claims 1 and 20 as anticipated by Stasz. Stasz does not disclose a suction opening that is longitudinally formed in the electrode terminal body and is laterally oriented on the wall of the body. As such, Stasz does not disclose every element of amended claims 1 and 20, and cannot anticipate claims 1 and 20 as amended or the claims that depend therefore. Applicants respectfully submit that amended claims 1 and 20, as well as dependent claims 2-19, are in condition for allowance, and request withdrawal of the rejection.

**Information Disclosure Statement**

Applicants enclose an Information Disclosure Statement and PTO Form 1449 for the Examiner's review and consideration.

### CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants hereby authorize the commissioner to charge \$180 for the IDS to Deposit Account No. 50-0359 of ArthroCare Corporation.

Applicants believe there are no further fees due at this time, however, the Commissioner is hereby authorized to charge any additional fees necessary or credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.358.5925.

Respectfully submitted  
Attorney for Applicants,



Matthew Scheele  
Reg. No. 59,847

Date: 5/13/08

SEND CORRESPONDENCE TO:

ARTHROCare CORPORATION

CUSTOMER NO. **21394**

512.358.5925

512.391.3901 (fax)

Enclosure: 1) Information Disclosure Statement and PTO Form 1449